THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

Ex parte WILLIAM F. PINELL and WILLIAM M. SALUKE

_____

Appeal No. 97-1452
Application 07/876,105[1]

_____

ON BRIEF

_____

Before KIMLIN, JOHN D. SMITH and ELLIS, **Administrative Patent Judges**.

ELLIS, **Administrative Patent Judge**.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 3 and 5. Claim 6 is also pending, but has been indicated by the examiner as containing allowable subject matter.

[1] Application for patent filed April 30, 1992. According to the appellants, the application is a continuation of Application 07/339,972, filed April 18, 1989, now abandoned.

Claim 1 is illustrative of the subject matter on appeal and reads as follows:

1. A sheet or web useful in ion deposition printing employing a polymeric-based toner and comprising a sheet or web substrate, a coating on at least one surface of said substrate which enhances the adhesion of said toner adhered to said coated surface, said coating comprising a polymeric latex wherein when said toner disposed on said coated surface is subjected to transfixation in an unheated nip, said toner is retained on said coated surface in an amount which is greater than the amount of toner retained on an uncoated surface of said substrate after toner on said coated and uncoated surfaces has been subjected to a tape test, and wherein said polymeric latex is present on said substrate in an amount of between about 0.7 and about 4.6 lbs. per 3000 ft^2 of substrate surface.

Claims 1 through 3 and 5 stand rejected under 35 U.S.C. § 112, first paragraph, as being based on a non-enabling disclosure.

Having considered the entire record on appeal which includes the specification, the appellants' Brief (Paper No. 23) and the examiner's Supplemental Answer (Paper No. 26),[2] we find ourselves in full agreement with the appellants' position. Accordingly, we reverse.

The examiner's rejection reads in its entirety:

> [c]laims 1-3 and 5 are rejected under 35 U.S.C. § 112, first paragraph, because the specification does not enable any

[2] The original Answer (Paper No. 24) was remanded to the examiner by this Board for correction. Accordingly, for purposes of this appeal we have considered the examiner's arguments as presented in the Supplemental Answer (Paper No. 25).

> person skilled in the art to which it pertains, or which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The claims are broader than the enabling disclosure [Supplemental Answer, sentence bridging pp. 3-4].

It is well established that the examiner has the "burden of giving reasons, supported by the record as a whole, why the specification is not enabling.... Showing that the disclosure entails ***undue*** experimentation is part of the PTO's initial burden... " ***In re Angstadt***, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA 1976). ***See also, In re Marzocchi***, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971) ("A specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented ***must*** be taken as in compliance with the enabling requirement of the first paragraph of § 112 ***unless*** there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support").

In neither the rejection, nor his response to the appellants' arguments, does the examiner provide a single reason as to why the specification fails to enable one skilled in the

art to make a composition wherein the toner is retained on a coated surface in an amount which is greater than the amount of toner retained on an uncoated surface as described in claim 1, ***supra***. Accordingly, the rejection is reversed.

The decision of the examiner is reversed.

REVERSED

EDWARD C. KIMLIN Administrative Patent Judge	)
JOHN D. SMITH Administrative Patent Judge	) BOARD OF PATENT)) APPEALS AND)) INTERFERENCES
JOAN ELLIS Administrative Patent Judge	)

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